

REMARKS

Applicant thanks the Examiner for the thorough consideration given the present application. Claims 5 and 7 are currently being prosecuted. The Examiner is respectfully requested to reconsider his rejections in view of the amendments and remarks as set forth below.

Entry of Amendment

It is respectfully requested that the present amendment should be entered into the official file in view of the fact that the amendments to the claims automatically place the application in condition for allowance. Alternatively, if the Examiner does not agree that the application is in condition for allowance, it is respectfully requested that the present amendment should be entered for the purposes of appeal. The present amendments help to reduce the issues on appeal by overcoming the art rejections suggested by the Examiner. Accordingly, the issues on appeal are reduced by reducing the number of rejections.

Rejection under 35 U.S.C. § 102

Claims 4-6 stand rejected under 35 U.S.C. § 102 as being anticipated by Konomi (U.S. Patent 4,588,867). This rejection is respectfully traversed.

By way of the present amendment, Applicant has canceled claims 4 and 6 and changed the dependency of claim 5. Accordingly, this rejection is rendered moot.

**Rejection under 35 U.S.C. § 103**

Claims 4-6 stand rejected under 35 U.S.C. § 103 as being obvious over Kobayashi et al. (U.S. Patent 6,061,459) in view of Konomi. This rejection is respectfully traversed.

Claims 4 and 6 have been canceled and claim 5 has been amended to depend from claim 7. Accordingly, this rejection is rendered moot.

Applicant is submitting herewith claim 7 which more clearly describes the present invention. Claim 7 describes a portable telephone having a combination of elements including a telephone case with an opening and a side wall, a sound producing device set in the telephone case, a casing of the sound producing device having a sound discharging nozzle projected from the casing with the sound discharging nozzle being inserted in the opening of the telephone case. This combination of elements is not seen in the cited references. Specifically, the Konomi reference does not show a portable telephone. It also does not have a telephone case with an opening formed in the side wall and a separate sound producing device within a casing with a sound discharging nozzle projecting

therefrom and inserted into the opening of the telephone case. Accordingly, claim 7 defines over this reference.

The Kobayashi et al. reference also does not show the present invention. This reference does not show a discharging nozzle projecting from the casing of the sound producing device into an opening of the telephone case. In fact, this reference is similar to the prior art device described in Fig. 5. Accordingly, Applicant submits that claim 7 defines over either of these references or their combination.

Furthermore, Applicant submits that the Kobayashi et al. reference may not be used in an obviousness rejection. This reference qualifies as prior art only under § 102(a) and §102(e). Since the patent date of May 9, 2000 is antedated by the claimed priority date of the present application, namely, October 22, 1999, if a verified translation of the priority document is filed, the reference then qualifies only under 35 U.S.C. § 102(e). Under 35 U.S.C. § 103(c), prior art which qualifies only under 35 U.S.C. § 102(e) may not be used in an obviousness rejection if the reference and the application are commonly assigned at the time the invention was made. It is noted that the patent is assigned to Citizen Electronics Company Limited as indicated on the cover page of the patent. The present application was assigned to the same company by way of an Assignment submitted on October 19, 2000 and recorded at

Reel 011246 and Frame 0494. Due to this common assignment, the Kobayashi et al. reference may not be used in an obviousness rejection. Applicant will submit a verified translation of the priority document if required by the Examiner.

Claim 5 depends from claim 7 and as such is also considered to be allowable. In addition, this claim specifically recites the cylindrical cushion between the inside wall of the opening and the outside wall of the sound discharging nozzle. Accordingly, this claim is believed to be additionally allowable.

#### Conclusion

In view of the above remarks, it is believed that the claims clearly distinguish over the patents relied on by the Examiner, either alone or in combination. In view of this, reconsideration of the rejections and allowance of all the claims are respectfully requested.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) respectfully petition(s) for a two (2) month extension of time for filing a reply in connection with the present application, and the required fee of \$420.00 is attached hereto.

Appl. No. 09/691,210  
Amendment dated February 24, 2004  
Office Action dated September 24, 2003

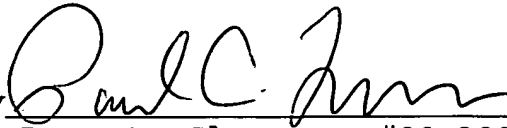
Docket No.: 3542-0111P  
Group Art 2642  
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Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Robert F. Gnuse (Reg. No. 27,295) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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